Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GYLES PANTHER
and J. PETER WILLIAMS

Appeal No. 1998-1471
Application No. 08/108,510

ON BRIEF

Before JERRY SMITH, GROSS, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 25 and 27.[1] We reverse.

BACKGROUND

The invention at issue in this appeal relates to paging receivers. To save battery power, a paging receiver "sleeps"

[1]The record indicates that the amendment filed on April 7, 1997 was entered.

for certain times, turning itself on at predetermined intervals to check whether it is being addressed by a transmitter. A time-division multiplexed form of such addressing is specified by the "POCSAG" paging format. With this form of addressing, however, power consumption is constant regardless of channel traffic. Another disadvantage is that, if a receiver is required to receive large amounts of data during off peak hours, it must operate continuously.

The inventive paging receiver transitions to a low power mode on command for a dynamically controlled time. Such a sleep command takes the form of a special address that affects all pagers preprogrammed to respond so; it determines the sleep period. Absent the sleep command, the paging receiver operates in the standard POCSAG format.

Claim 25, which is representative for our purposes, follows:

> 25. A radio pager receiver comprising means for manually shutting the receiver off, means for automatically turning on the manually shut off receiver for receipt and storage of cyclically transmitted wireless

> messages at predetermined times, and means for automatically shutting off the automatically turned on receiver after one of receipt of said wireless messages and determining that no such wireless messages exist.

The references relied on in rejecting the claims follow:

Murai et al. (Murai) 5,274,843 Dec. 28, 1993
(effectively filed Nov. 23, 1988)

Morishima 3-24825 Feb. 1, 1991.[2]
(Japanese Patent Application)

Claims 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murai in view of Morishima. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answers for the respective details thereof.

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[2]A copy of the translation prepared by the U.S. Patent and Trademark Office is attached. We will refer to the translation by page number in this opinion.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 25 and 27. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we consider the scope of the claims.

"'[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim ....'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). Here, claim 25 specifies in pertinent part the following limitations: "means for manually shutting the receiver off, means for automatically turning on the manually shut off receiver for receipt and storage of cyclically transmitted wireless messages at predetermined times ...." Similarly, claim 27 specifies in pertinent part the following limitations: "manually shutting the receiver off, automatically turning on the manually shut off receiver at predetermined times for receipt and storage of cyclically transmitted wireless messages ...." Accordingly, claims 25 and 27 each require automatically turning on a receiver that has been manually shut off.

The examiner fails to show a suggestion of the limitations. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551-53, 220 USPQ 303, 311-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner admits, "Murai lacks a teaching of turning ON the receiver after the receiver has been manually shut OFF via switch 710." (Examiner's Answer at 4.) For its part, the reference discloses that its paging apparatus operates only when its manual power "switch 710 is turned on ...." Col. 5, ll. 22-23.

The examiner fails to show that Morishima remedies this defect. Although the reference teaches automatically turning on the main power of a selective call receiver, it does not turn on the receiver when the receiver has been manually shut off. To the contrary, Morishima discloses that the receiver operates only when its manual power switch 710 is turned on. Specifically, "the main power of the receiver can be turned on/off automatically ... as long as the power switch (7) is left on." Translation, p. 12. Similarly, "the main power of the receiver can be turned on automatically ... as long as the power switch (7) is left on." Id. at 14.

Because Murai and Morishima require a manual power switch to be left on to operate their paging apparatus and selective

call receiver, respectively, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitations of "means for manually shutting the receiver off, means for automatically turning on the manually shut off receiver for receipt and storage of cyclically transmitted wireless messages at predetermined times" or "manually shutting the receiver off, automatically turning on the manually shut off receiver at predetermined times for receipt and storage of cyclically transmitted wireless messages ...." The examiner impermissibly relies on the appellants' teachings or suggestions. He has not established a prima facie case of obviousness. Therefore, we reverse the rejection of claims 25 and 27 under 35 U.S.C. § 103.[3]

CONCLUSION

In summary, the rejection of claims 25 and 27 under 35 U.S.C. § 103 is reversed.

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[3]Our reversal is based only on the disclosures of Murai and Morishima. It does not preclude the examiner from finding and applying a reference that teaches or suggests automatically turning on a receiver that has been manually shut off as claimed.

REVERSED

JERRY SMITH Administrative Patent Judge	)
ANITA PELLMAN GROSS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

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